REMARKS

I. General Remarks

Claims 1-20 are pending in the application. In the final Office Action mailed January 25, 2005, claims 1-20 have been finally rejected. The issues in the Office Action are:

- Claims 1, 5, 7, 15-17, 19, and 20 are rejected under 35 U.S.C. § 102(b) as anticipated by *Cooper et al.* (U.S. Patent No. 4,742,388, hereinafter *Cooper*);
- Claims 2, 8-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooper* in view of *Adair* (U.S. Patent No. 5,812,188);
- Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooper* in view of *Shiomi* (U.S. Patent No. 6,650,361);
- Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooper* in view of *Safai et al.* (U.S. Patent No. 6,167,469, hereinafter *Safai*); and
- Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooper*.

II. Claim Rejections under 35 U.S.C. § 102(b)

Claims 1, 5, 7, 15-17, 19, and 20 are rejected under 35 U.S.C. § 102(b) as anticipated by *Cooper*.

Claim 1 recites "an image sensor sensing multi-color pixel data corresponding to said optical image." The image sensor of *Cooper* produces "a signal having sequential portions corresponding to the color fields of light". *See* col. 3, lines 43-44. Because the *Cooper* invention utilizes a light source and a color wheel (Col. 3, lines 27-28), the image produced by the image sensor of *Cooper* must be limited to sequential monochrome portions corresponding to the light passed by each filter of the filter wheel. Accordingly, *Cooper* does not disclose an image sensor sensing multi-color pixel data corresponding to said optical image as recited in the amended claim 1.

Furthermore, Applicant respectfully disagrees with the Examiner's characterization of the *Cooper* reference in the "Response to Arguments" section of the Final Office Action. The Examiner states that the *Cooper* reference discloses an image sensor which "senses multicolor (red, blue and green light signal the [sic] make up the image) picture data of an image." *Cooper* does not teach multi-color pixel data. Applicant respectfully notes that *Cooper* refers to "*the* true color [emphasis added] viewed by the image sensor," apparently indicating that the image sensor sees only one color at a time. *See Cooper,* col. 5, lines 41-42. Referring now to the present subject matter, each point of multi-color pixel data is "captured on three pixels, a green sensitive pixel, a blue sensitive pixel and a red sensitive pixel." *See* page 8, lines 24-25. Accordingly, Applicant respectfully asserts that *Cooper* does not teach the recited limitation of claim 1 of "an image sensor sensing multi-color pixel data." As shown above, *Cooper* does not anticipate claim 1. Applicant respectfully requests that the Examiner withdraw the rejection of record and pass claim 1 to allowance.

Regarding claim 15, Applicant respectfully disagrees with the Examiner's characterization of *Cooper* in the Response to Arguments section of the Final Office Action. Claim 15 recites "recording an image on an electronic media of said digital visual recording device which includes said combined filtering effects." *Cooper* describes three memory storage devices, each of which is preferably a dynamic random access memory (DRAM), for storing digital data corresponding to the output signal for one particular color field from image sensor 72. *See* col. 4, line 66 to col. 5, line 3. *Cooper* teaches "an output processor 60 generates a composite RGB video signal by taking data from two color fields prior in time out of their DRAMs and combining this data with the data from one color field which has been transferred directly from the switching circuitry 62." *See* col. 5, lines 10-15. *Cooper* does not appear to create an image which includes combined filtering effects until "output processor 60 generates a composite RGB video signal." Accordingly, *Cooper* does not teach at least the claim 15 limitation of "recording an image on an electronic media of said digital visual recording device which includes said combined filtering effects." Because *Cooper* does not disclose the limitation of recording an image on an electronic media of said digital visual recording device which includes said combined filtering effects, *Cooper* does not anticipate claim 15. Applicant respectfully requests that the Examiner withdraw the rejection of claim 15 under 35 U.S.C. § 102(b) and pass claim 15 to allowance.

Each of claims 5, 7, 16-17, and 19-20 depend either directly or indirectly from base claims 1 and 15. As such, each of claims 5, 7, 16-17, and 19-20 comprise all limitations of the base claims. *Cooper* does not teach all limitations of base claims 1 and 15, and accordingly does not teach all limitations of claims 5, 7, 16-17, and 19-20. Thus, *Cooper* does not anticipate claims 5, 7, 16-17, and 19-20. Applicant respectfully requests that the Examiner withdraw the rejection of claims 5, 7, 16-17, and 19-20 under 35 U.S.C. § 102(b) and pass these claims to allowance.

III. Claim Rejections under 35 U.S.C. § 103(a)

Improper Motivation

Claims 2 and 8-14 have been rejected under 35 U.S.C. § 103(a) as obvious over *Cooper* in view of *Adair*. To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second or third criteria, Applicant respectfully asserts that the first criteria has not been met.

The Examiner admits that the *Cooper* reference does not disclose a graphic user interface. *Adair* teaches an encapsulated endoscopic video monitor with touch screen switches. The Examiner states that "[i]t would have been an obvious design decision for one of ordinary skill in the art to have been motivated to modify [*Cooper* in view of *Adair*] to have a touch screen display to input controls as taught by Adair." However, it is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* In re Mills, 916 F.2d 680, 16

U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Not All Limitations

Claims 2, 3-4, 6, 9-14, 18

Each of claims 2, 3-4, 6, 9-14, 18 are rejected under 35 U.S.C. § 103(a) as being obvious over *Cooper*, either by itself, or in view of another reference. To establish a prima facie case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicant respectfully asserts that the third criteria has not been met.

Claims 2 and 9-14 have been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper* in view of *Adair*. *Cooper* does not teach all of the limitations of claim 1, as discussed above. Claim 2 depends from claim 1 and therefore contains all of the limitations of the base claim. *Adair* does not cure the deficiency of *Cooper* as support for a 35 U.S.C. § 103(a) rejection. Accordingly, the cited references do not teach or suggest all of the claim limitations of claim 2. Furthermore, the Examiner has not provided proper motivation to combine the references. Accordingly, claims 9-14 are not properly rejected as unpatentable over *Cooper* in view of *Adair*. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claims 2 and 9-14 to allowance.

Claims 3 and 4 have been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper* in view of *Shiomi*. *Cooper* does not teach all of the limitations of claim 1, as discussed above. Claims 3 and 4 depend from claim 1 and therefore contain all of the limitations of the base claim. *Shiomi* does not cure the deficiency of *Cooper* as support for a 35 U.S.C. § 103(a) rejection. Accordingly, the cited references do not teach or suggest all of

the claim limitations of claims 3 and 4. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claims 3 and 4 to allowance.

Claim 6 has been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper* in view of *Safai*. *Cooper* does not teach all of the limitations of claim 1, as discussed above. Claim 6 depends from claim 1 and therefore contains all of the limitations of the base claim. *Safai et al.* does not cure the deficiency of *Cooper* as support for a 35 U.S.C. § 103(a) rejection. Accordingly, the cited references do not teach or suggest all of the claim limitations of claim 6. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claim 6 to allowance.

Claims 18 has been rejected under 35 U.S.C. § 103(a) as unpatentable over *Cooper*. *Cooper* does not teach all of the limitations of claim 15, as discussed above. Claim 18 depends from claim 15 and accordingly contains all of the limitations of the base claim. Because *Cooper* does not teach all of the limitations of claim 15, a 35 U.S.C. 103(a) rejection of claim 18 is not proper. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record and pass claim 18 to allowance.

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10002214-1, from which the undersigned is authorized to draw.

Dated: March 22, 2005

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482745551US, in an envelope addressed to: Alexandria, VA 22313-1450, on the date shown below.

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